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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,746	01/15/2004	Matthias Konrad	03/005 MFE	4292
38263	7590	04/19/2006	EXAMINER	
PROPAT, L.L.C. 425-C SOUTH SHARON AMITY ROAD CHARLOTTE, NC 28211-2841			TRAN, THAO T	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/757,746

Applicant(s)

KONRAD ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/21/2006 has been entered.
2. Claims 1-3, 5-11, 13-21 are currently pending in this application. Claim 4 has been canceled. Claim 21 has been newly added. Claims 1, 14, and 19 have been amended.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-11, 13-18, and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (US Pat. 4,957,980).

Kobayashi teaches a multilayered polyester film for packaging and a method of making, the polyester film comprises a polyester resin composition having 100 parts by weight of a thermoplastic polyester resin and 1-100 parts by weight of a polyamide resin, or specifically 90 parts of the polyester resin and 5 parts of the polyamide resin containing m-xylylenedipamide

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(MXD) (see abstract; col. 1, l. 29-35; col. 2, ln. 53-62; Table 1, Example 1), and additives such as antioxidants or UV absorbing agents or antistatic agents (stabilizers) (see 4, ln. 10-14).

Kobayashi further teaches the polyester resin is composed of repeating units of terephthalate, isophthalate, or naphthalene, and ethylene glycol (see col. 2, ln. 28-45). In Example 1, Kobayashi discloses the use of 5% by weight of MDX in the composition, reading on the presently claimed invention.

Kobayashi further discloses the multilayered polyester film being formed by extrusion and biaxial orientation (see col. 4, ln. 49-52). The film has an oxygen permeation of 35cc/m<sup>2</sup>.d.atm (.35cc/bottle (1000cc).d.atm) and an opacity of 6% (haze) (see col. 5, ln. 17-21; Table 1, Example 1).

Although the reference does not specifically teach the gloss, planar orientation, and roughness values of the overlayer, since the reference teaches the same chemical components of the multilayer, the overlayer would inherently have the same gloss, planar orientation, and roughness as presently claimed.

Since claim 16 recites a filler of 0% concentration, the filler is not required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi as applied to claim 1 above.

Kobayashi is as set forth in claim 1 above and incorporated herein.

Kobayashi further teaches that at least one of the layers is made of the polyester resin containing a polyamide resin having m-xylene groups (see abstract). Kobayashi further discloses in the background section of the invention that a thermoplastic polyester resin not including polyamide containing m-xylene has been widely used in the art.

Therefore, it would have been obvious to one of ordinary skill in the art that at least one of the layers of the molded article would have been of a polyester resin without the addition of a polyamide containing m-xylene, since this resin has been a conventional resin commonly used in the art in the production of molded articles in packaging that provides excellent mechanical properties, transparency, chemical resistance, and excellent processing properties (see col. 1, ln. 18-28).

### ***Response to Arguments***

7. Applicant's arguments filed on 3/21/2006 have been fully considered but they are not persuasive.

On page 7 of the Remarks, Applicants argue that the presently claimed invention differs from Kobayashi '980 in that the presently claimed invention comprises the MXD6-containing polyester films having at least one overlayer including either no or very moderate amounts of MXD6 to obtain improved barrier properties and surface gloss. Applicants further specifies that the amount of MXD being up to 20%. As shown in Table 1 in Kobayashi '980, the amount of

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MXD used are 5%, 10%, and 20%, which read on the instantly claimed range. Thus, the polyester films of Kobayashi would inherently have the same properties, such as barrier properties, orientation, and surface gloss as presently claimed.

In response to Applicants' arguments that Kobayashi provides a laundry list of the polyamides, which may be present in amounts of up to 50%, it is noted that the laundry list Kobayashi presents in column 2 includes all polyester resin (A) and poly(m-xylylenediamine) (B). These include different species of thermoplastic polyester and MXD, thus they read on the presently claimed invention because the instant claims do not specify any species of the thermoplastic polyester or MXD. With respect to the amounts of MXD in the composition, Kobayashi presents them to be 1-100 parts by weight in 100 parts of the thermoplastic resin and 0.01-50 parts of the compatibilizer (C). And in all the Examples, Kobayashi uses 5%, 10%, or 20% of the MXD in the composition, which read on the presently claimed invention.

In response to Applicants' arguments that Kobayashi uses a compatibilizer to improve the optical properties of articles made from polyester/polyamide blends, it is noted that while this is true, the amount of the compatibilizer is not the only parameter determining the degree of transparency of the layer, but the combination of all three components whether they are present or absent (see Table 1 for various compositions and transparencies). Examples 1 and 8 have different amounts of the compatibilizer but the same transparencies.

8. In summary, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Applicants are reminded that in

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an article claim, it is the structural or chemical components, and not properties, that impart patentability. To patentably distinguish the presently claimed invention from the prior art, Applicants should provide structural or chemical elements that give the films their properties different from the prior art.


***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt  
April 17, 2006

  
THAO T. TRAN  
PATENT EXAMINER